



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 09/847,709 | 05/03/2001 | Marvin Moser | IDS 118673 (3037-4190) | 7018 |

7590 01/26/2005

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

| |
|----------|
| EXAMINER |
|----------|

KIM, JUNG W

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2132

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/847,709 | MOSER, MARVIN | |
| | Examiner | Art Unit | |
| | Jung W Kim | 2132 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/3/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-55 have been examined.

Claim Objections

2. Claim 49 is objected to because of the following informalities: the sentence is not grammatical (line 3). Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 5-10, 12, 14-19, 21, 23-55 are rejected under 35 U.S.C. 101 as not being tangible. As per claims 1, 3, 5-10, 12, 14-19, 21, and 23-47, the steps of storing, selecting, creating, transforming, transferring, receiving and issuing are not tangibly embodied in a manner so as to be executable. The language of the claims raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter. *State Street*, 149 F. 3d at 1373, 47 USPQ2d at 1601-1602. MPEP 2106. As per claims 48-55, since the system is not directed to a specific hardware element, the claims are non-statutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. U.S. Patent No. 6,125,186 (hereinafter Saito) in view of W3C HTML 4.01 Specification (hereinafter W3C).

6. As per claims 1, 2 and 4, Saito discloses a method that restricts access to a WWW script comprising the steps of:

- a. storing an encrypted script and storing a decryption program in a server capable of decrypting the encrypting script (see Saito, col. 15:1-5; the applet is the decryption program);
- b. wherein a user's WWW browser downloads the encrypted script and the decryption program, and decrypts the encrypted script with the decryption program (see Saito, col. 15:6-29);
- c. wherein the script runs in the WWW browser (see Saito, col. 15:29-30).

7. Saito does not expressly teach a hypertext object including a reference to the encrypted script and a reference to the decryption program wherein access to the hypertext object only allows access to the encrypted script. W3C teaches incorporating

Art Unit: 2132

a hypertext object within an html page to invoke objects that perform dynamic tasks, including functions defined by applets; furthermore, the hypertext object includes parameters to identify the location of remote data read in by the objects to perform the dynamic tasks. See W3C, section 13.3, especially section 13.3.1, 'Inline vs. external data'; section 13.4. It would be obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of W3C with the invention of Saito since the invocation of remote objects and remote data sets using hypertext enables access to dynamic programs and data sets from a remote location, which enables greater flexibility to store and retrieve programs and data sets. Ibid. Finally, a web server serves the hypertext to the WWW browser. The aforementioned cover the limitations of claims 1, 2 and 4.

8. As per claims 3, 5 and 6, Saito covers a method as outlined above in the claim 1, 2 and 4 rejections. In addition, each of the hypertext object, the encrypted script and the decryption program are downloadable (ibid); further, it has been found to be obvious to consolidate multiple objects. See *In re Larson* 144 USPQ 347 (CCPA 1965). The aforementioned cover the limitations of claim 3, 5 and 6.

9. As per claim 7, Saito covers a method as outlined above in the claim 1, 2 and 4 rejections. In addition, the steps of: selecting an encryption algorithm, selecting an encryption key, and creating the encrypted script by executing the encryption algorithm

Art Unit: 2132

and applying the encryption key are necessary steps to encrypt a script as known to one of ordinary skill in the art. The aforementioned cover the limitations of claim 7.

10. As per claims 8 and 9, Saito covers a method as outlined above in the claim 7 rejection. In addition, it is notoriously well-known that symmetric encryption and public key encryption are the two encryption techniques to secure digital information. Examiner takes Official Notice of this teaching. It would be obvious to one of ordinary skill in the art to use symmetric encryption or public key encryption to secure the script since these methods are well implemented and have been found to be secure. The aforementioned cover the limitations of claims 8 and 9.

11. As per claims 10-18, Saito covers a method as outlined above in the claim 1-9 rejections. In addition, an encrypted script, by definition, conceals and restricts access to the script. The aforementioned cover the limitations of claims 10-18.

12. As per claims 19-27, Saito covers a method as outlined above in the claim 10-18 rejections. In addition, the hypertext object modifies a reference to the script to refer to the encrypted script and further modified to include a reference to the decryption program. See Saito, col. 14:65-15:6 and 15:15-25; trusted agent performs the modification. The aforementioned cover the limitations of claims 19-27.

Art Unit: 2132

13. As per claims 28-47, Saito covers a method as outlined above in the claim 10-18 rejections. In addition, the method restricts access to the script by invoking the following steps (see Saito, col. 14:62-15:30; see W3C, section 13.3, especially section 13.3.1):

- d. receiving request for a hypertext object including a reference to an encrypted script and a reference to a decryption program capable of decrypting the encrypted script (client request access to encrypted script and decrypting applet from web server using WWW browser);
- e. transferring the hypertext object (response by web server to client);
- f. receiving the hypertext (client receives web page from web server);
- g. issuing a request for the decryption program (hypertext object within web page requests for remote applet: parameter identifies location of applet);
- h. receiving a request for the decryption program (web server receives applet request from client browser);
- i. transferring the decryption program (web server sends applet to client browser)
- j. issuing a request for the encrypted script (data parameter of hypertext object identifies location of remote data source to supply invoked applet);
- k. receiving a request for the encrypted script (remote data source receives request to supply remote data);
- l. transferring the encrypted script (remote data source transmits remote data);

- m. decrypting the encrypted script (applet decrypts supplied encrypted data);
- and
- n. presenting the hypertext object on a display device (WWW browser reproduces unencrypted data).

The aforementioned cover the limitations of claims 28-47.

14. As per claims 48-55, they are system claims corresponding to claims 1-47 and they do not teach or define above the information claimed in claims 1-47. Therefore, claims 48-55 are rejected as being unpatentable over Saito in view of W3C for the same reasons set forth in the rejections of claims 1-47.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

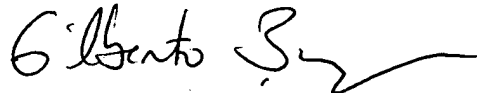
Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim
Examiner
Art Unit 2132

Jk
January 12, 2005



GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100